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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,874	11/17/2000	Carl M. Sullivan	30222/20:100	7638

3528 7590 07/28/2003

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EXAMINER
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FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

13

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

ASB

# Office Action Summary

Application No.

09/715,874

Applicant(s)

SULLIVAN ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-11,18,19,21-23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-11,18,19,21-23 and 25-29 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment mailed May 5, 2003.

Claims 1, 2, 10, 18, 19, 21, 22, 23 and 25 were amended with claims 6, 20 and 24 canceled and claims 27-29 added, rendering claims 1-5, 7-11, 18-19, 21-23 and 25-29 pending.

***Claim Rejections – 35 USC § 103(a)***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 8-11, 18-19, 21-23 and 25-29 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over Greenlee (U.S. 5,248,546).

Greenlee discloses a multilayered article comprising a first layer of polyvinyl chloride and a second layer of polyvinyl chloride, which are adjacent to each other (column 2, lines 17-45) where the PVC compounds contain plasticizers (column 5, lines 8-14). Greenlee discloses the PVC containing layers comprise antistatic agents having levels less than 20phr(column 6, lines 44-55) which is a surface reactive agent. The reference discloses the plasticizer ranges from 0.5 to 10 phr (column 5, lines 56-65).

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Greenlee discloses along with the addition of plasticizers, copolymers can be incorporated in the layers as well (column 6, lines 20-26) such as polyester adipates (column 14, line 56 through column 15, line 5). In instant claim 18, 'a total thickness of up to 2 mil' equates to 0mil, which is met by the prior art reference. The reference discloses the second layer is at least three degrees Celsius higher than the heat distortion temperature (melting point) of the first layer (column 2, lines 36-40). In instant claim 3, the phrase, 'promotes ambient or latent moisture' constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation, but only requires the ability to so perform. Additionally, in instant claim 3, '...to uniformly spread on the surface of the film' is held to be a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Greenlee does not show that the at least two layers have different gas permeabilities as in instant claims 28 and 29. However, such gas permeabilities are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the gas permeabilities, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize

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operation conditions (e.g. gas permeabilities) fails to render claims patentable in the absence of unexpected results. The aforementioned limitation is optimizable as it directly affects the breathability and integrity of the multilayered PVC article. As such, it is optimizable. It would have been obvious to one of ordinary skill in the art to make the multilayered PVC article with the limitations of the gas permeabilities since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980). Although Greenlee does not refer to the article specifically as a packaging film, it is obvious to the average artisan that a sheet can be used as a liner for packaging materials, which is further supported where Greenlee discloses the multilayered article is acceptable for direct food contact (column 3, lines 1-5) which has the same function and capability as a packaging film.

4. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

5. Applicant's arguments of rejection under 35 USC 103(a) as unpatentable over Watanabe et al. (U.S. 5,929,133) are considered moot based on grounds of new rejection. Additionally, Applicant's arguments of rejection under 35 USC 103(a) as being

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unpatentable over Watanabe et al (U.S. 5,929,133) in view of Purdy (U.S. 4,565,738) are considered moot based on grounds of new rejection.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

